UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,087	03/02/2004	Hiroki Iwahashi	1081.1192	1171

21171   7590   07/14/2005

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER
LASTRA, DANIEL

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>07 April 2005</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6,7,9-15,17,18 and 20-25* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6,7,9-15,17,18 and 20-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)	4)☐ Interview Summary (PTO-413)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	5)☐ Notice of Informal Patent Application (PTO-152)
Paper No(s)/Mail Date <u>04/15/05</u>.	6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-4, 6, 7, 9-15, 17, 18 and 20-25 have been examined. Application

10/790,087 has a filing date 03/02/2004 and is a continuation of PCT/JP01/09018

International Filing Date: 10/12/2001.

Response to Amendment

2.   In response to Non Final Rejection filed 12/07/2004, the Applicant filed an

Amendment on 04/07/2005, which amended claims 1, 9, 12, 13, 17, 20, 23, cancel

claims 5, 8, 16, 19 and added new claim 25.

Claim Objections

3.   Claims 6 and 17 are objected to because are recited dependent of a cancel

claim. For purpose of art rejection, claim 6 is dependent of claim 1 and claim 17 is

dependent of claim 12.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 4, 9-12, 15, 16 and 20-22 and 25 are rejected under 35 U.S.C. 103(a)

as being unpatentable over Freeman et al (U.S. 6,068,183) in view of Fajkowski (US

5,905,246).

As per claims 1, 12 and 25, Freeman teaches:

A method of providing advertisements by an automatic transaction apparatus for executing a predetermined transaction with a user utilizing a transaction medium that stores identification information of the user, the method comprising the steps of:

reading the identification information stored in the transaction medium (see column 4, lines 60-67);

acquiring attribute information of the user corresponding to the identification information read out from the transaction medium, from a host computer connected with the automatic transaction apparatus through a network (see column 3, lines 45-55; column 5, lines 1-10; column 4, lines 35-40); and

displaying an advertisement corresponding to the attribute information among a plurality of advertisements registered for each of plural pieces of attribute information (see) and

issuing a coupon corresponding to the advertisement after displaying the advertisement (see column 3, lines 14-20; column 4, lines 10-15; column 5, lines 1-10) Freeman does not teach *by printing said coupon on a predetermined sheet.* However, Fajkowski teaches a coupon (i.e. chip) card system that allows consumers to stored electronic coupons in a coupon card and also prints said stored coupons in hard copy form (see Fajkowski column 27, line 25 – column 28, line 2). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Freeman would display coupons' advertisements to consumers based upon said consumers' profile data obtained from the multitude of environments that process said consumers' chip cards (e.g. **ATM** machines; see Freeman column 2,

lines 19-29) and would issue coupons to said consumers (see Freeman column 3, lines 14-20; column 4, lines 10-15; column 5, lines 1-10) by printing said coupons on a predetermined sheet, as taught by Fajkowski. The printed coupons would serve as a "shopping list" to said consumers.

As per claims 4 and 15, Freeman teaches

The method of providing advertisements according to claim 1, wherein in the case where a plurality of advertisements are registered for the attribute information, one advertisement is selected for display depending on the priority set in advance for each advertisement (see Freeman column 4, lines 60-67; column 5, lines 44-65).

As per claims 9 and 20, Freeman teaches:

The method of providing advertisements according to claim 1, wherein the automatic transaction apparatus accumulates the number of times of issuance of the coupon for each issuance either by the printing or by the registering of data (see Freeman column 2, lines 25-29).

As per claims 10 and 21, Freeman teaches:

The method of providing advertisements according to claim 1, wherein the attribute information includes at least one of the age, the sex and the balance in a deposit account set in a predetermined financial institution of the user (see Freeman column 3, lines 45-55).

As per claims 11 and 22, Freeman teaches:

The method of providing advertisements according to claim 1, wherein the transaction medium is an IC card (see Freeman column 2, lines 9-30).

Claims 2, 3, 6, 7, 13, 14, 17 and 18 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Freeman et al (U.S. 6,068,183) in view of Fajkowski (US 5,905,246)

and further in view of Angles et al (U.S. 5,933,811).

As per claims 2, 3, 6, 13, 14 and 17, Freeman teaches

The method of providing advertisements according to claim 1, but fails to teach

wherein: the automatic transaction apparatus accumulates the number of times of

display of the advertisement every time it displays the advertisement, and wherein the

host computer acquires the number of times of display of the advertisement from the

automatic transaction apparatus and, after a predetermined period of time has passed,

creates charging information corresponding to the number of times of display and

wherein in the case where the advertisement is registered for the plural pieces of the

attribute information, the number of times of display of the advertisement is

accumulated for each piece of the attribute information and wherein the automatic

transaction apparatus accumulates the number of times of issuance of the coupon

every time it issues the coupon, and the host computer acquires the number of times of

issuance from the automatic transaction apparatus and, after a predetermined period of

time has passed, creates charging information corresponding to the number of times of

issuance, wherein the automatic transaction apparatus comprises a calculation unit for

accumulating the number of times of display of the advertisement every time the

advertisement is displayed, and wherein the calculation unit transmits the number of

times of display of the advertisement to the host computer that creates charging

information corresponding to the number of times of display after a predetermined

period of time has passed, wherein the calculation unit accumulates the number of

times of display of the advertisement for each piece of the attribute information in the

case where the advertisement is registered for the plural pieces of attribute information.

However, Angles teaches "In addition, the ability to monitor the number of

advertisements displayed by a particular content provider computer 14 provides a

number of advantages. For example, the advertisement provider can pay the content

provider based on the volume of advertisements actually displayed by the content

provider computer 14. This frees the content providers from having to generate

advertising data, from having to individually contact advertisers, from having to

negotiate advertising payment fees, and from having to maintain an advertising

administrative staff. (105) Furthermore, because the preferred embodiment of Angles

also is capable of storing a consumer's Internet provider account number in the

registration database 68, the preferred embodiment can monitor the number of

advertisements viewed by consumers associated with a particular Internet provider 34.

Accordingly, the invention can pay an Internet provider 34 based on the number of

advertisements viewed by its consumers. The Internet providers 34 can then use this

advertising revenue to reduce consumer access fees. Alternatively, the preferred

embodiment can pay a consumer for viewing advertisements by crediting a consumer's

Internet provider account. In addition, because the preferred embodiment also is

capable of storing a consumer's digital cash account, the preferred embodiment can pay

the consumer with digital cash each time the consumer views an advertisement. This

allows the consumer to obtain digital cash which the consumer can use to purchase

other goods and services offered for sale on the Internet 33" (see column 16, lines 16-44). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Freeman system would track and analyze the number of times advertisements are displayed to users, as taught by Angles. Freeman would use this tracking to analyze the effectiveness of the advertisement efforts and would use this analysis to settle transactions between consumers, advertisers and content providers.

As per claims 7 and 18, Freeman teaches:

The method of providing advertisements according to claim 6, wherein in the case where the advertisement and a coupon corresponding thereto are registered for the plural pieces of attribute information, the number of times of display of the advertisement and the number of times of issuance of the coupon are accumulated for each piece of attribute information (see Freeman column 3, lines 45-55; column 4, lines 17-34; column 2, lines 20-30).

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Freeman (US 6,068,183).

As per claim 23, Freeman teaches:

A transaction system executing a predetermined transaction with a user, the transaction system comprising:

an automatic transaction apparatus for accepting a transaction medium that stores identification information of the user (see column 2, lines 20-25; "ATM"; column 5, lines 1-10); and

a host computer for communicating attribute information of the user (see column 5, lines 1-10), connected with the automatic transaction apparatus through a network, the automatic transaction apparatus comprising:

a read-out-unit for reading out the identification information stored in the transaction medium (see column 5, lines 1-10);

an acquisition-unit-for acquiring attribute information of the user corresponding to the identification information read out from the transaction medium from a host computer (see column 4, lines 40-48);

a storage unit for storing at least one advertisement corresponding to each of plural pieces of attribute information (see column 4, lines 40-47); and

a display-unit for displaying the advertisement corresponding to the attribute information from advertisements stored in the storage-unit (see column 5, lines 1-10).

As per claim 24, Freeman teaches:

The transaction system according to claim 23, wherein the automatic transaction apparatus issues a coupon corresponding to the advertisement after displaying the advertisement (see column 3, lines 10-20).

Response to Arguments

6.   Applicant's arguments filed 04/07/2005 have been fully considered but they are not persuasive. The Applicant argues that Freeman does not teach a method of providing advertisements by an automatic transaction apparatus (ATM) for executing a predetermined transaction with a user utilizing a transaction medium that stores identification information of the user.

The Examiner answers that Freeman teaches in column 2, lines 20-25 "The invention also enables businesses to target advertising and other information for transmission to customers by analyzing detailed consumer profiles built from demographic and transaction information. The information sent to the chip card is presented to the consumer whenever the consumer uses the chip card. Further, businesses can both send information and collect consumer profile data from the multitude of environments that process chip cards (e.g., telephones, screen phones, computers, **ATM machines**, parking meters, vending machines, stadium ticket facilities, GSM devices, gas pumps, copy machines, laundromats, theaters, casino gaming machines, etc.). Additionally, businesses can track the success of their consumer targeting efforts. For example, a business may record when an electronic coupon was sent to a consumer and if and when the consumer redeemed the coupon". Therefore, Freeman teaches "a method of providing advertisements by an automatic transaction apparatus (ATM) for executing a predetermined transaction with a user utilizing a transaction medium that stores identification information of the user", similar to the Applicant's claimed invention.

With respect to Applicant's argument of the newly added feature that Freeman does not teach the printed coupon. The Examiner wants to point that the Examiner is relying on Fajkowski to teach the newly added feature.

Conclusion

7.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.   Accordingly, **THIS ACTION IS MADE FINAL.**   See MPEP § 706.07(a).   Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).   A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action.   In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action.   In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720. The examiner can normally be reached on 9:30-6:00.
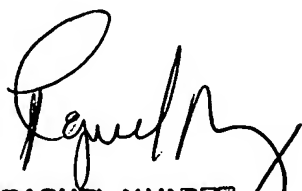
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724.   The Examiner's Right fax number is 571-273-6720.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.   Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Lastra

July 6, 2005

RAQUEL ALVAREZ
PRIMARY EXAMINER